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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/905,508	08/04/97	SHAYESTEH	L 023070-06772

HM22/0228

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SAN FRANCISCO CA 94111-3834

EXAMINER
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ARTHUR, L

ART UNIT	PAPER NUMBER
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1655

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DATE MAILED: 02/28/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/905,508

Applicant(s)

Shayesteh et al.

Examiner

Lisa Athur

Group Art Unit

1655



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-22 \_\_\_\_\_ is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-22 \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. This application is a continuing prosecution application which was filed on November 17, 1998.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1,2,4-13,16-19,21,22, drawn to methods and kits involving the detection of a PIK3CA gene, classified in class 435, subclass 6.
- II. Claims 1,3,5-13,16-18,20-22 drawn to methods and kits involving the detection of a GLUT2 gene, classified in class 435, subclass 6.
- III. Claims 14-15, drawn to a method involving the detecting a nucleic acid at 3q26.3 and at 19q13.1-19q13.2, classified in class 435, subclass 6.

The inventions are distinct, each from the other because:

The methods of inventions I-III are different because they depend upon the detection of different genes which are both located in a relatively large region of chromosome 3 such that the association to cancer of one of the genes (such as PIK3CA) is not obvious over an association to cancer of the other gene (i.e. GLUT2). If the alteration is a specific mutation in one of the genes, a probe which detects the other gene not having the mutation associated with cancer would not detect the chromosomal alteration. Invention III is further distinct from inventions I and II because it requires the hybridization to two different regions on two different chromosomes which is not an obvious variation of a method of detecting a sequence in one of the regions. Because the target nucleic acids sequences of all of the inventions are different, the reagents used in each of

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these methods is different. Therefore, all of these inventions are novel and unobvious over one another

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by the different classification and divergent subject matter, restriction for examination purposes as indicated is deemed proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Arthur whose telephone number is (703) 308-3988. The examiner can normally be reached on Monday-Wednesday from 8:00am to 4:30pm. The examiner can also be reached on alternate .

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



LISA B. ARTHUR  
PRIMARY EXAMINER  
GROUP 1800-1600

February 28, 2000